

Docket: 103431-45879

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: FRANK B. NORMAN
Filed: May 13, 1999
Serial NO: 09/311,611
Title: INTERACTIVE REVERSE CHANNEL FOR
DIRECT BROADCAST SATELLITE SYSTEM
Examiner: Christopher Grant
Group Art Unit 2611

Official



BOX AF - VIA FAX (703) 872-9314
Assistant Commissioner for Patents
Washington, D.C. 20231

**PETITION FOR WITHDRAWAL OF FINALITY DESIGNATION
AND OFFICE ACTION**

It is requested that the Office Action dated December 31, 2002 be withdrawn and that the finality designation be withdrawn. The Office Action improperly rejects claims 22-36 and 38-40 under 35 U.S.C. 103(a) as being unpatentable over the patent to Aras et al. in view of the patent to Slezak et al (U.S. Patent No. U.S. Patent No. 6,006,257), because Slezak et al. does not qualify as prior art. The Slezak et al. patent was filed September 27, 1996 and thus does not qualify as prior art to the present application.

Although it does claim priority from provisional application no. 60/004,575 filed September 29, 1995, the utility patent application that matured into U.S. Patent No.

6,006,257 contains subject matter not found in the provisional patent application, that is, subject matter pertaining to the Internet.

On page 3 of the Office Action, the deficiency of the Aras et al. patent is discussed as follows and resort was made to the Slezak et al. patent to make up for such a deficiency:

Although Aras discloses communication over the Internet (at col. 26, lines 40-41) and a local distribution network separate from the satellite network (figure 4B), he fails to specifically disclose providing a full-time communication path between the first and second Internet interfaces involving an ISP and coordinating subscriber activities with schedule information as recited in the claims.

Slezak discloses a receiver (504,508) in communication with CATV server (510) via a cable network (74) and in full-time communication with the server (510) via an Internet network (530). An Internet interface at server (510), an Internet interface at receiver (504, 508) and an Internet service provider (ISP) are all necessary components for communicating over the Internet. Slezak's system enables the receiver (504, 508) to receive television programs and additional information via the Internet. The Internet communication provides bi-directional communication to the receiver (504, 508). See the entire reference including but not limited to figure 1 and col. 4, line 65-col. 5 line 60.

The undersigned has been advised by Canadian counsel for the applicant that the provisional patent application serial no. 60/004,575, from which the Slezak et al. patent claims priority, makes no reference to the Internet or any teaching of use of a full-time connection to the Internet for the purpose of collecting statistics related to viewing habits. In accordance with the provisional patent application, which is some 60 pages long, requests for voice or video services are issued via a narrowband PSTN or the broadband PSTN. The content is delivered over the broadband PSTN.

Although it was pointed out in the last Amendment filed 10/23/2002 that the Slezak et al. patent does not qualify as prior art to the present application because its subject matter, which the Examiner relies on to reject the present claims, may not be found in the provisional patent application from which Slezak et al. patent claims priority, the Office responded to this argument as follows:

In response, the Examiner posits that applicant is **totally incorrect**. The effective filing date of the instant application is 06/24/1996. The effective filing date of the Slezak reference is 9/29/1995. Therefore, Slezak pre-dates the instant application by over eight months.

Secondly, Slezak (a reference that pre-dates Applicant's filing date) also discloses using a computing device with a web browser to retrieve data from a Web page that contained information that was previously posted by another computing device (See col. 5, lines 33-54).

The Examiner's position is without merit because it ASSUMES that all the pertinent subject matter being relied upon in the utility patent application that matured into U.S. Patent No. 6,006,257 to reject the claims is found in provisional patent application serial no. 60/004,575, from which the Slezak et al. patent claims priority. Such an assumption is misguided and **totally incorrect**.

The situation is analogous to whether a continuation-in-part patent application has an effective filing date of that of the parent patent application as to subject matter that is not found in the parent application. MPEP 2133.01 finds that the effective date under such a situation is that of the Child CIP.

2133.01 Rejections of Continuation-In-Part (CIP) Applications

When applicant files a continuation-in-part whose claims are not supported by the parent application, the

effective filing date is the filing date of the child CIP. Any prior art disclosing the invention or an obvious variant thereof having a critical reference date more than 1 year prior to the filing date of the child will bar the issuance of a patent under 35 U.S.C. 102(b). *Paperless Accounting v. Bay Area Rapid Transit System*, 804 F.2d 659, 665, 231 USPQ 649, 653 (Fed. Cir. 1986).

Although provisional patent applications have not been in existence as long as continuation-in-part applications so there may not be as much case law, the same determination as to the effective filing date applies. As to subject matter not supported by the provisional patent application, the effective filing date of the patent with respect to such subject matter is that of the utility patent application filing date, not the provisional patent application filing date. Note that MPEP 2136.05 (bold, italicize and underline added for emphasis) requires that the subject matter provisional application "supports" all the claims of the U.S. application to antedate a prior art reference.

2136.05 Overcoming a Rejection Under 35 U.S.C. 102(e)

A 35 U.S.C. 102(e) REJECTION CAN BE OVERCOME BY ANTEDATING THE FILING DATE OR SHOWING THAT DISCLOSURE RELIED ON IS APPLICANT'S OWN WORK

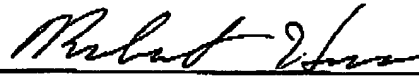
When a prior U.S. patent, or when examining PG-PUB applications (see MPEP § 2136), a prior U.S. patent application publication or international application publication, is not a statutory bar, a 35 U.S.C. 102(e) rejection can be overcome by antedating the filing date (see MPEP § 2136.03 regarding critical reference date of 35 U.S.C. 102(e) prior art) of the reference by submitting an affidavit or declaration under 37 CFR 1.131 or by submitting an affidavit or declaration under 37 CFR 1.132 establishing that the relevant disclosure is applicant's own work. *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969). The filing date can also be antedated by applicant's earlier foreign priority application or provisional application if 35 U.S.C. 119 is met and the foreign application or provisional application "supports" (conforms to 35 U.S.C. 112, first paragraph, requirements)

all the claims of the U.S. application. *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989). But a prior application which was not copending with the application at issue cannot be used to antedate a reference. *In re Costello*, 717 F.2d 1346, 219 USPQ 389 (Fed. Cir. 1983). A terminal disclaimer also does not overcome a 35 U.S.C. 102(e) rejection. See, e.g., *In re Bartfeld*, 925 F.2d 1415, 17 USPQ2d 1885 (Fed. Cir. 1991).

The granting of this petition is earnestly solicited.

Dated: February 13, 2003

Respectfully submitted,



Robert J. Hess
Reg. No. 32,139

GIBBONS, DEL DEO, DOLAN
GRIFFINGER & VECCHIONE
One Pennsylvania Plaza - 37 Floor
New York, NY 10119-3701
Tel (212) 649-4700
Fax (212) 333-5980

GIBBONS, DEL DEO, DOLAN, GRIFFINGER & VECCHIONEA PROFESSIONAL CORPORATION
ATTORNEYS AT LAWONE PENNSYLVANIA PLAZA, 37TH FLOOR
NEW YORK, N.Y. 10119-3701OFFICE: (212) 649-4700
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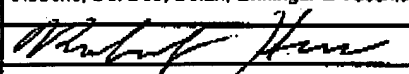
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/311,611	
	Filing Date	May 13, 1999	
	First Named Inventor	Frank B. NORMAN	
	Art Unit	2811	
	Examiner Name	Christopher C. GRANT	
Total Number of Pages in This Submission	6	Attorney Docket Number	103431-45879

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Remarks 1. Petition for Withdrawal of Finality Designation and Office Action.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Robert J. Hess (Reg 32,139) Gibbons, Del Deo, Dolan, Griffinger & Vecchione
Signature	
Date	February 13, 2003

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